

### **REMARKS/ARGUMENTS**

The Office Action mailed October 1, 2004 has been reviewed and carefully considered. Claim 8 has been amended. Claims 15 and 16 are added. Claims 8-16 are pending in this application, with claim 8 being the only independent claim. The Office Action mailed October 1, 2004 was discussed in a telephonic interview dated January 13, 2005 between Examiner Michael H. Thaler and Alfred W. Froebrich. The subject matter of the telephonic conversation is discussed below. Reconsideration of the above-identified application, as herein amended and in view of the following remarks, is respectfully requested.

In the Office Action mailed October 1, 2004, the disclosure is objected to because Figure 3 does not show ring 18 as being an inner ring. The Examiner indicated the lead line appears to refer to the wrong element. Fig. 3 is amended to extend the lead line for reference numeral 18 to show that ring 18 is an inner ring relative to sleeve 12. In view of the amendment and remarks, the objection to the disclosure should now be withdrawn.

The amendment filed on June 21, 2004 is objected to because the Examiner states that the new Fig. 4 and the new paragraph added after line 32 of page 6 introduce new matter. Both Fig. 4 and the paragraph added after line 32 of page 6 have been canceled from the specification. Accordingly, the objection to the amendment should be withdrawn.

Claims 8-14 stand rejected under 35 U.S.C. §112, first paragraph, as failing to provide an adequate description of the claim limitations in the specification. More specifically, the Examiner states that it is unclear from the disclosure how the proximal end of the actuation rod 6 is releasably connected to bar 19. The Examiner further states that it is unclear how the movement of the bar 19 affects the attachment of rod 6 to bar 19.

This rejection was discussed extensively during the telephonic interview of January 13, 2005. Applicant's representative indicated that the specification discloses that the bar 19 is adjustable in the direction shown by double arrow 21 (page 6, lines 24-25). The specification also states that bar 19 includes a receive 22 for positive fitting insertion of the proximal end of the actuation rod 6 (page 6, lines 27-28). The specification states that bar 19 may be fixed in a locking position and a release position by a ball lock formation 23 (page 6, lines 28-32). As discussed during the telephonic interview, Fig. 3 shows two indentations for receiving the ball of the ball lock formation in the locking position and the release position, respectively. Therefore, the above-referenced portion of the specification discloses that the bar 19 is movable between a locking position and a release position and that the proximal end of the actuation rod 6 is connectable by a positive fitting connection to the bar 19. The only feature that is not specifically disclosed is the specific positive fitting insertion. As explained below, a releasable positive fitting connection of an actuation bar in an endoscopic instrument is known to one skilled in the art of endoscopic instruments and, therefore, the specification does provide an adequate description which enables one skilled in the art to make and use the claimed invention.

As delineated in *In re Howarth*, 210 USPQ 689, 691 (CCPA 1981), to meet the enablement requirements under §112 an inventor need not explain every detail since he is speaking to those skilled in the art and what is conventional knowledge will be read into the disclosure. *In re Howarth*, at 692, further states that part of the skills of such persons includes not only basic knowledge of the particular art to which the invention pertains, but also the knowledge of where to search for the materials, and public records concerning U.S. Patents are likely to be checked.

U.S. Patent 5,607,449 (Tontarra) discloses an actuating bar 9 that is releasably held by a sleeve 83 which is movable by a pushbutton 82. The sleeve has an opening with a round hole

87 adjoining a narrow slot 88. The sleeve 83 is moved to a release position in which the head 90 of the actuating bar 9 is aligned with and passes through the round hole 87. The sleeve may then be moved so that the narrowed section 93 of the actuating bar 9 is held in the slot for holding the actuating bar 9 (see, e.g., col. 6, lines 35-45; and Fig. 7 of Tontarra). The actuation bar 9 of Tontarra is analogous to the actuation rod 6 of the present invention and the sleeve 83 of Tontarra is analogous to the bar 19 of the present invention.

As described above, the only specific information not disclosed is the releasable positive-fitting connection. Such a fitting was known to those skilled in the art at the time of the invention as disclosed, for example, in U.S. Patent 5,607,449 (Tontarra).

In view of the above remarks, those skilled in the art would have known at the time of the invention how to releasably connect the actuating rod 6 to bar 19. Accordingly, the rejection of claims 8-14 under 35 U.S.C. §112, first paragraph, should be withdrawn.

Claims 10 stands rejected under 35 U.S.C. §112, second paragraph as being indefinite because the Examiner states that it is unclear how the covering can have circumferential shape. Claim 10 has been amended to recite "said trough comprises an edge defining a shape of said opening of said trough, said covering sufficiently covering said trough in said closed position so that an entire sample within the volume defined between said opening and said closed end is prevented from leaving said trough". Support for this amendment is found on page 5, lines 12-15, of the specification. In view of the above amendments and remarks, the rejection of claim 10 should now be withdrawn.

Claims 8-14 stand rejected under 35 U.S.C. §103 as unpatentable over U.S. Patent No. 4,926,877 (Bookwalter).

Before discussing the cited prior art and the Examiner's rejections of the claims in view of that art, a brief summary of the present invention is appropriate. The present invention relates to an endoscopic sample taker. To perform this function, the sample taker must be inserted into a subject to the area at which a sample is to be taken, take cartilage from that area, and be removed with the sample of cartilage. The present invention discloses an instrument that has a scoop 2 defining a spoon-shaped or shell-shaped trough 5 (see page 5, lines 2-4, of the specification). Furthermore, a movable covering 7 is arranged in a hollow shank 1 of the instrument which can be moved between an open position and a closed position (see page 5, lines 29-31). The covering is a thin strip of bendable material (page 5, lines 8-9). Furthermore, the section which covers the trough 5 has a shape that matches the circumferential shaped of the trough 5 so that the cover adequately covers the trough to maintain the sampled cartilage therein (page 5, lines 9-15).

Independent claim 8 has been amended to recite that the trough is spoon-shaped and defines a opening and a closed end. Support for this amendment is found in the specification at page 5, line 2, and in Figs. 2 and 3. In contrast to the claimed invention, Bookwalter discloses a biopsy needle which includes a hollow tubular body bore 12 with a cutting blade assembly 14 (col. 3, lines 49-52). The hollow tube of Bookwalter punctures the skin of the patient and blade assembly cuts the sample in the tube to keep the sample in the tube when the needle is removed (col. 5, lines 32-56; Fig. 3). During the telephonic interview, the Examiner broadly interpreted the term spoon-shaped and stated that the front end of Bookwalter might be considered spoon-shaped because the diameter of the needle slightly decreases at the front end. If anything, the shape of the front end of the needle in Boodwalter may be considered conical. However, this does not disclose a spoon shape having an opening and a closed end, as now expressly cited in independent claim 8. As discussed in the telephone conversation of January 13, 2005, the Examiner's interpretation is that the hollow

shaft ends at some point and the trough begins. However, this interpretation fails to disclose a trough having an opening and a closed end. Rather, the only closed end is the end of the hollow shaft. Accordingly, the sample taker disclosed by Bookwalter can not be considered to have a spoon-shaped trough with an opening and closed end, as expressly recited in independent claim 8. Furthermore, there is no need for Bookwalter to have a spoon-shaped trough because it is designed to take samples of soft tissue by pushing the needle through the flesh (col. 5, lines 47-56). Accordingly, independent claim 1 is allowable over Bookwalter.

Dependent claims 9-16, being dependent on independent claim 8, are deemed allowable for at least the same reasons expressed above with respect to independent claim 8.

Dependent claim 10 further recites that the cover prevents the entire sample in the volume between the opening and the closed end of the trough from being removed. However, in Bookwalter, the cover does not cover the opening of the needle. Rather, it leaves a certain volume between the cover and the opening of the needle. Accordingly, dependent claim 10 is allowable over Bookwalter for these additional reasons.

New dependent claim 15 recites that "a volume defined between said opening and said closed end of said trough of said scoop is separated from a volume defined by said hollow shank". Support for this limitation is in Figs 2 and 3. Assuming *arguendo* that the front end of the needle in Bookwalter is the trough of a scoop, then the volume of the trough of Bookwalter is in direct communication with the volume of the hollow shank and is not separated from the volume of the hollow shank, as recited in independent claim 15. Accordingly, dependent claim 15 is allowable over Bookwalter for these additional reasons.

New dependent claim 16 recites that "an entire volume defined between said opening and said closed end of said trough of said scoop is arranged distally of said distal end of

said hollow shank by an axial distance". Support for this limitation is found, e.g., in Fig. 2 of the specification. Bookwalter fails to disclose, teach or suggest this limitation. Even if the front of the needle is considered a trough, the volume of that trough is directly connected to the hollow shaft of the needle. Accordingly, claim 16 is allowable over Bookwalter for these additional reasons.

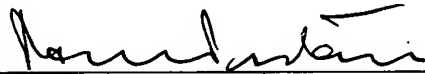
In view of the above amendments and remarks, the application is now deemed to be in condition for allowance and notice to that effect is solicited.

It is believed that no fees or charges are required at this time in connection with the present application. However, if any fees or charges are required at this time, they may be charged to our Patent and Trademark Office Deposit Account No. 03-2412.

Respectfully submitted,

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**Amendments to the Drawings:**

The attached sheet of drawings includes Fig. 3. This sheet, which includes Fig. 3 is amended to correct the lead line for reference number 18.

Please cancel Fig. 4 which was added by the amendment filed on June 21, 2004.

Attachment: Replacement Sheet